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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,880	12/05/2003	Katsunari Tezuka	14539-005002 / JF-82US-C1	9815
26161	7590	03/24/2008		
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER	
			OUSPENSKI, ILIA I	
			ART UNIT	PAPER NUMBER
			1644	
			MAIL DATE	DELIVERY MODE
			03/24/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/729,880

Applicant(s)

TEZUKA ET AL.

Examiner

ILIA OUSPENSKI

Art Unit

1644

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date 09/05/2007.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment and remarks, filed on 12/07/2007, are acknowledged.

Claim 18 is pending.

The rejections of record can be found in the previous Office Action, mailed on 09/10/2007.

The rejections of record have been withdrawn in view of Applicant's amendment and arguments, except as set forth herein.

2. The following is a quotation of the **first paragraph of 35 U.S.C. 112**:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 18 is rejected under **35 U.S.C. 112, first paragraph**, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicant is not in possession of the claimed method, because Applicant is not in possession of the generically recited "human AILIM."

It is acknowledged that in the previous Office Action, it was suggested that amending the claims to recite "human AILIM" may obviate the rejection of record. However, upon further consideration, and upon consultation with a Technical Quality Assurance Specialist, the following is noted:

The instant specification discloses at page 17, lines 26 – 30, that "AILIM" of the instant invention includes a polypeptide having substantially the same amino acid sequence as that of AILIM of each mammal described in the references, and particularly preferably, that of human AILIM. The specification further discloses at page 17, lines 31 – 35, that "having substantially the same amino acid sequence" means that a polypeptide may have multiple amino acids substituted, deleted, and/or modified. Therefore, the recitation of "human AILIM" is still deemed to read on multiple sequence variants, and as such, the rejection of record set forth in the previous Office Action at pages 2 – 4, applies to the instant claims, as amended.

Therefore, the rejection of record is maintained for the reasons of record, as it applies to the amended claim. The rejection of record is incorporated by reference herein, as if reiterated in full.

As a possible means of obviating this rejection, Applicant is invited to consider providing sufficient written support in the instant specification for the amino acid sequence(s) of human AILIM as described in documents JP-A Hei 11-29599 (Japanese Patent Application No. Hei 10-62217), which corresponds to WO98/38216 (PCT/JP98/O0837), to which incorporation by reference was made at page 17, lines 7 – 18 and 26 – 30, of the instant specification as-filed, and to amend the claims to refer to the corresponding SEQ ID Number(s).

If the amino acid sequence(s) of human AILIM are introduced into the instant specification; they *must also be included in the sequence listing and CRF* and provided a sequence identifier in order to comply with the sequences rules under 37 CFR 1.821 through 1.825.

Regarding incorporation by reference, the following is noted:

An application as filed must be complete in itself in order to comply with 35 U.S.C. 112; however this does not bar incorporation by reference. Ex parte Schwarze, 151 USPQ 426 (Bd. of Appeals, 1966). An application for a patent when filed may incorporate "essential material" by reference to (1) a United States patent or (2) an allowed U.S. application, subject to the conditions set forth below. "Essential material" is defined as that which is necessary to (1) support the claims, or (2) for adequate disclosure of the invention (35 U.S.C. 112). "Essential material" may not be incorporated by reference to (1) patents or applications published by foreign countries or regional patent offices, to (2) non-patent publications, to (3) a U.S. patent or application which itself incorporates "essential material" by reference or to (4) a foreign application. See In re Fouché, 169 USPQ 429; 439 F.2d 1237 (CCPA 1971).

Nonessential subject matter may be incorporated by reference to (1) patents or application published by the United States or foreign countries or regional patent offices, (2) prior filed, commonly owned U.S. applications or (3) non-patent publications, for purposes of indicating the background of the invention or illustrating the state of the art.

Applicant is reminded that when the disclosure is amended to include the material incorporated by reference, the amendment *must* be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See In re Hawkins, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); In re Hawkins, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and In re Hawkins, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

4. Conclusion: no claim is allowed.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILIA OUSPENSKI whose telephone number is (571)272-2920. The examiner can normally be reached on Monday-Friday 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen B. O'Hara can be reached on 571-272-0878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ILIA OUSPENSKI, Ph.D./
Primary Examiner, Art Unit 1644
February 20, 2008

/Eileen B. O'Hara/
Supervisory Patent Examiner, Art Unit 1644